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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/320,702	05/27/1999	TOMOYUKI HANAI	450100-4893	5176
20999	7590	04/07/2004	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			HOYE, MICHAEL W	
			ART UNIT	PAPER NUMBER
			2614	

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/320,702

Applicant(s)

HANAI ET AL.

Examiner

Michael W. Hoyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-15, 17, 18 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11, 13-15, 17 and 20 is/are allowed.
- 6) ☒ Claim(s) 12, 18 and 21-27 is/are rejected.
- 7) ☒ Claim(s) 11 and 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 May 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The previously indicated allowability of dependent claims 12, 18 and 21, if rewritten in independent form including all of the limitations of the base claim and any intervening claims, which are now independent claims 12, 18 and 21, is withdrawn in view of new grounds of rejection in view of Hawkins et al (USPN 6,005,561). Rejections based on the previously cited reference follow.

#### ***Claim Objections***

2. Claim 11 is objected to because of the following informalities: the abbreviation "EPG" should be written as --Electronic Program Guide-- for the first time the term is used in the claims. Appropriate correction is required.

Claim 21 is objected to because of the following informalities: on line 7 of the claim the word "base" should be --based--. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 12, 18, 21-23 and 26-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Hawkins et al (USPN 6,005,561).

As to claim 12, note the Hawkins et al reference which discloses a recording device or user terminal. The claimed receive means is met by the user terminal (see col. 6, lines 37-52), which receives the claimed EPG data added with supplemental information indicating the data quantity of a program as met by the transmission system or head end, which generates supplemental information containing the program data quantity or length of the program and may be added or incorporated with the EPG data (see col. 11, lines 19-67), which is included in the transmission of data to the receiver or user terminal. The claimed program data is transmitted as a digital signal (see col. 6, lines 53-57 and col. 8, lines 41-48). The claimed control means to extract said supplemental information from the EPG data is met by the decoder which extracts the information from the media objects such as the EPG (col. 6, lines 46-52 and col. 10, lines 1-11). The claimed supplemental information includes the category of said program and said control means controls selection of a recording media to record said program data based on said supplemental information and on category information set for said recording media is met by category information and viewer preferences which may be used in the selection of recording similar types of programs based on viewer preferences (see col. 9, lines 6-8; col. 10, lines 46-67; col. 11, lines 40-58; col. 18, lines 12-13 and 20-21 and col. 19, lines 27-31).

As to claim 23, Hawkins et al discloses the claimed recording device wherein the recording media is comprised of one unit as met by the user terminal with a storage medium (col. 18, lines 11-12).

As to claim 18, the claimed method is rejected based on the same arguments given above for claim 12.

As to claim 21, the claimed media for providing a program is rejected based on similar arguments given above for claim 12.

As to claims 26 and 27, the claimed supplemental information further includes category information set for said recording media is met by category information and viewer preferences which may be used in the selection of recording similar types of programs based on viewer preferences (see col. 9, lines 6-8; col. 10, lines 46-67; col. 11, lines 40-58; col. 18, lines 12-13 and 20-21 and col. 19, lines 27-31).

As to claim 22, note the Hawkins et al reference which discloses a recording system. The claimed generating means to generate EPG data is met by the head end broadcasting a program guide or EPG (see col. 6, lines 37-48 and col. 78-11). The claimed supplementing means is also met by the transmission system or head end, which generates supplemental information containing the program data quantity or length of the program and may be added or incorporated with the EPG data (see col. 11, lines 19-67). The claimed transmit means to multiplex the program data with EPG data added with the supplemental information and transmitting the information as a digital signal is met by the server node or head end which transmits the data stream including media objects, motion video, data objects, broadcast programming content information, broadcast programming information program guide in a multiplexed fashion through the use of a MPEG-2 data transport (see col. 8, lines 38-56 and col.23, lines 45-57). The claimed receive means is met by the user terminal (see col. 6, lines 37-52), which receives the claimed EPG data and program data, which is met by the supplemental information containing

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the program data quantity or length of the program that may be added or incorporated with the EPG data, which is included in the transmission of data to the receiver or user terminal as described above (see col. 11, lines 19-67). The claimed control means to extract said supplemental information from the EPG data is met by the decoder which extracts the information from the media objects such as the EPG (col. 6, lines 46-52 and col. 10, lines 1-11). The claimed supplemental information includes the category of said program and said control means controls selection of a recording media to record said program data based on said supplemental information and on category information set for said recording media is met by category information and viewer preferences which may be used in the selection of recording similar types of programs based on viewer preferences (see col. 9, lines 6-8; col. 10, lines 46-67; col. 11, lines 40-58; col. 18, lines 12-13 and 20-21 and col. 19, lines 27-31).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al.

As to claims 24 and 25, the Hawkins et al reference discloses a recording device with a storage medium, including a hard disk, or a CD ROM, as described above in claim 12 (also see col. 18, lines 12-14 and 20-21). Although the Hawkins et al reference does not explicitly

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disclose that the recording device is connected by way of a bus and external recording media, the examiner takes Official Notice that it is notoriously well known in the art of consumer electronics devices, such as recording devices, to connect additional devices to a device by means of a bus, such as, an IEEE 1394 configuration bus for the advantage of allowing quick and easy connection to additional devices, including cameras, hard disk drives, CD ROM drives, etc... and, more importantly, allowing for high speed digital transmission between the devices. Therefore, it is submitted that it would have been clearly obvious to one of ordinary skill in the art at the time of the invention to incorporate a bus, such as an IEEE 1394 configuration bus, for connecting a recording device to an external recording media for the advantages given above.

***Allowable Subject Matter***

7. Claims 11, 13-15, 17 and 20 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: as for claim 11, the prior art, alone or in combination, does not teach or fairly suggest a recording device... which receives EPG data added with average bit rate data as information indicating the data quantity of a program, and control means that calculates the data quantity of a program from the average bit rate data, and controls selection of a recording media to record program data based on the data quantity of the program and the capacity of the recording media. As for the most pertinent prior art of record, the Hawkins et al (USPN 6,005,561) reference discloses an average size and bit requirement or rate for each particular object, including a short video or program (see Fig. 5 and col. 12, lines 58-65). In Fig. 6, Hawkins discloses the amount of storage required by all media objects (col. 13, lines 14-16), and in Fig. 8, Hawkins discloses size

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requirements, overall bandwidth (or bit rate) requirements, and transmission times (col. 17, lines 36-53). However, Hawkins et al does not explicitly disclose adding the information indicating the data quantity of a program as average bit rate data to the EPG data, and there is no suggestion to control selection of a recording media. Another reference, Bruls (US 2002/0012530), discloses a recording device that monitors the actual bit rate of a video program that is being recorded and adjusts the compression settings accordingly to achieve the target actual average bit rate in order to fit the program in the available data space (see Abstract and pg. 1, ¶¶0001-0012)). However, Bruls does not explicitly disclose adding information indicating the data quantity of a program as average bit rate data to the EPG data at the headend, and there is no suggestion to control selection of a recording media based on the data quantity of the program and capacity of the recording media. One of ordinary skill in the art would not have been motivated to arrive at the applicants' claimed invention by using the teachings of the Hawkins and/or Bruls references alone or in combination. The Hawkins and Bruls references do not teach or suggest a recording device... wherein the receive means receives EPG data added with average bit rate data as information indicating the data quantity of a program, and control means calculates the data quantity of said program from said average bit rate data, and controls selection of a recording media to record said program data based on the data quantity of said program and the capacity of said recording media. In the applicants' invention, the recording device as described above is disclosed.

As to claim 17, the claimed recording method is allowable based on the same reasons given above for claim 11.



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As to claim 20, the claimed media for providing a program is allowable based on similar reasons given above for claim 11.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael W. Hoye whose telephone number is (703) 305-6954.

The examiner can normally be reached on Monday to Friday from 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller, can be reached at (703) 305-4795.

**Any response to this action should be mailed to:**

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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to customer service whose telephone number is **(703) 308-HELP**.

Michael W. Hoyer  
March 30, 2004



JOHN MILLER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600